



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,834	02/11/2002	David M. Koelle	G&C 30967.3-US-D1	5976

7590 11/21/2003

Attention: Karen S. Canady  
Gates & Cooper LLP  
Howard Hughes Center, Suite 1050  
6701 Center Drive West  
Los Angeles, CA 90045

EXAMINER
----------

MOSHER, MARY

ART UNIT	PAPER NUMBER
----------	--------------

1648

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/073,834

Applicant(s)

KOELLE ET AL.

Examiner

Mary E. Mosher, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-17,26,27 and 30-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-17,26,27 and 30-54 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Claims 1-17, 26, 27, 30-54 are drawn to a plurality of disclosed patentably distinct polypeptides comprising materially different amino acid sequences. The separate polypeptides bear distinct structural and/or biochemical properties, see as evidence the Roizman et al review cited in parent application 09/368,770, particularly page 850 and Figure 7. **Therefore, each disclosed patentably distinct polypeptide is considered a separate invention.**

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing which inventions are obvious variants of each other or clearly admit on the record which inventions are obvious variants of each other. If the inventions are deemed obvious variants of each other, then if the examiner finds one of the inventions unpatentable over the prior art, the evidence submitted by applicant or admission of record by applicant may be used in a rejection under 35 U.S.C. §103(a) of the other inventions.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- |            |      |   |
|------------|------|---|
| Inventions | 1-5. | Claims 1-6, 11, 26, 27, 30, 31, 35-38, 43-54 polypeptides and compositions, drawn to U <sub>L</sub> 19, U <sub>L</sub> 21, U <sub>L</sub> 49, gE, VP16 respectively, classified in class 424, subclass 231.1. |
| Inventions | 6-10 | Claims 7-10, 12-17, 32-34, 39-42, 43-50 polynucleotides and compositions, drawn to U <sub>L</sub> 19, U <sub>L</sub> 21, U <sub>L</sub> 49, gE, VP16 respectively, classified in class 514, subclass 44.      |

The inventions are distinct, each from the other because of the following reasons:

Inventions 1-5 are drawn to structurally and functionally distinct polypeptides.

Art Unit: 1648

The groups of Inventions 1-5, 6-10, Inventions 1-5 are drawn to polyamino acids, Inventions 6-10 are drawn to polynucleic acids, each group involving materials with distinct structural and functional characteristics. Although the nucleic acids can be used to make the polypeptides, the polypeptides can be made by materially different methods, such as chemical synthesis or isolation from HSV-infected cells.

Claims 43-50 link groups 1-5 and 6-10, and will be examined together with either the polypeptide or the nucleic acid elected.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, divergent search requirements, and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of **one** of the inventions 1-10 to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. Mosher, Ph.D. whose telephone number is 703-308-2926. The examiner can normally be reached on M-T and alternate F.

Art Unit: 1648

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 703-308-4027. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

11/18/03

*Mary Mosher*  
MARY E. MOSHER  
PRIMARY EXAMINER  
GROUP 1648-1608